

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Carr et al.

Application No.: 09/567,405

Filed: May 8, 2000

For: POSTAL METHODS AND SYSTEMS

Examiner: E. Cosimano

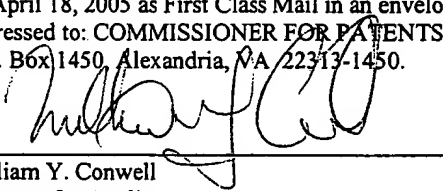
Date: April 18, 2005

Art Unit 3629

Confirmation No. 4836

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on April 18, 2005 as First Class Mail in an envelope addressed to: COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.


William Y. Conwell
Attorney for Applicant

DECLARATION OF DR. ADNAN ALATTAR

In connection with the captioned application, I, Adnan Alattar, declare as follows:

1. I hold the position of Senior Staff Research and Development Engineer with applicant Digimarc Corporation, and have been employed in that capacity since September 15, 1988.
2. Before joining Digimarc, I held positions at Intel Corporation and KFUPM University. My education includes a PhD in Electrical Engineering from North Carolina State University, awarded in 1989.
3. Through my work and experience, I have become skilled in the art of steganographic encoding, and am familiar with the meaning given such term by others in the art. I am also familiar with the distinctions between steganographic encoding, and visible data symbologies - such as bar codes.
4. I have reviewed the portions of the Office Action mailed December 16, 2004, in the captioned application, which construe and apply the Gilham patent (4,934,846). I have also reviewed the Gilham patent, and claims 5 and 8-11 against which Gilham has been applied.
5. On page 4 of the Action, the Patent Office states "*Hence, the indicia barcode of Gilham ... would be recognized as steganographic encoded information.*"

6. Likewise, on page 8 of the Action, the Patent Office states “*One of ordinary skill at the time the invention was made would have recognized that the process of generating the barcode in Gilham ('846) is a type of watermarking or a steganographic process...*”
7. These just-cited statements by the Patent Office are incorrect. Contrary to these statements, an artisan would not recognize the barcode indicia of Gilham as steganographic encoded information. Nor would one of ordinary skill have recognized the process of generating the barcode in Gilham as a steganographic process.
8. The barcode of Gilham is an *overt* indicia. Its presence is *conspicuous* to a viewer. Gilham's bar code (like all bar codes) presents human-apparent evidence that data is thereby represented.
9. Steganographically encoded information does not have these characteristics. Steganographically encoded information is *covert*. The presence of steganographically encoded information is *not conspicuous* to a viewer. Steganographic encoding does not present human-apparent evidence that data is thereby represented.
10. The Action notes (page 4) that an observer of Gilham would see the final barcode – not the actual information contained within the barcode. That is not the litmus test for steganographic encoding.
11. Steganographic encoding is not simply encoding from which the observer cannot see the *actual information*. Instead, steganographic encoding is encoding that *does not even evidence* that the encoded information is present.
12. The Action seems to confuse principles of encryption with those of steganography. Consider a simple letter-substitution encryption technique, in which the letter A is replaced with the letter B; the letter B is replaced with the letter C; ... and the letter Z is replaced with the letter A. In such an arrangement, the message “HELLO” would be encoded as “IFMMP.” An observer cannot see the *actual information* encoded (i.e., HELLO). However, it is evident to such an observer that some information is being represented. This is like the barcode of Gilham; an observer cannot see the

actual information encoded, but it is evident that some information is being conveyed or represented by the barcode.

13. In contrast, steganographically-encoded information is conveyed in such a manner than an observer does not even recognize that hidden information is being conveyed or represented. Consider the word COSIMANO. To the causal observer this looks like a name. No other information is apparent. However, the message "1010111" is steganographically encoded in this name. How? The spacings between the letters C-O, and S-I, and M-A, and A-N, and N-O are a half-point (i.e., about .0069 inches) greater than the spacings between the letters O-S and I-M. The larger spacing represents a binary "1" and the smaller spacing represents a binary "0." So hidden in the name COSIMANO is the steganographically encoded message 1010111. Gilham has no counterpart to such data hiding.
14. I believe the foregoing understandings regarding steganographic encoding, and the distinctions between steganographic encoding and barcodes, are shared by others skilled in the art.
15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Dr. Adnan Alattar

April 18, 2005

Date



UNITED STATES PATENT AND TRADEMARK OFFICE

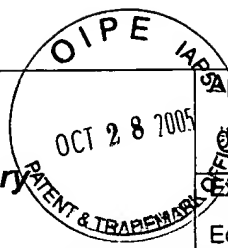
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/567,405	05/08/2000	J. Scott Carr	60188	4836
23735	7590	10/07/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary



Application No. 09/567,405	Applicant(s) CARR ET AL.	
Examiner Edward R. Cosimano	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 24 is/are allowed.
- 6) ☒ Claim(s) 5-18, 20 and 23 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

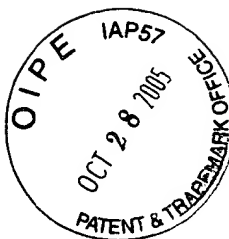
- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.



1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.

2. The proposed drawing correction filed 22 May 2003 has been approved by the examiner.

2.1 The sheets of drawings containing figs. 1-6 as filed 22 May 2003 are acceptable to the examiner.

3. The affidavit of Dr. Adnan Alattar has been considered.

4. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1, and

(2) the application data on page(s) 1, 4, 5 & 8,

in reference to applications 09/547,664 or 09/562,516 or 10/764,430 with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

B) in regard to the above status requirement, it is noted that application number 09/562,516 has been abandoned.

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

6. Claims 12-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claim 12, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, that is essential information/data and/or structure is missing so that as claimed invention does not work as a whole toward accomplishing the desired results and therefore one of ordinary skill could not determine from the language of these claims whether or

not they are in fact making and/or using what applicant has disclosed and claimed as the invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 12 and how can the device be triggered to produce a response corresponding to the machine readable indicia on the envelope, since as recited in this claim it is noted that the language of the limitations of this claim does not require that:

(1) the received envelope to include a "machine readable indicia";

(2) the "processing device that includes an optical sensing system" to use the "optical sensing system" in order to sense anything that may be on the envelope; and

(3) the "device to produce a response corresponding to machine readable indicia on said envelope" to receive the results of the "optical sensing system" so that it may produce the proper response to the "machine readable indicia on said envelope";

and hence it would be unclear what role/function/purpose the recited process would achieve and hence what credible utility does the claimed invention have.

6.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason, applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of

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paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7.1 Claim 7 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Gasper et al (5,919,730).

7.1.1 Since both the envelope and the purpose of containing an item as recited in claim 7 are merely statements directed to the intended use of the claimed invention which do not affect the operation of what is recited, this feature is non-functional descriptive material.

7.1.2 In regard to claim 7, Gasper et al ('730) in the environment of preventing the unauthorized copying of printed documents teaches that it was known by others at the time of the invention to use dots of two different sizes when printing copy restrictive documents where if a dot of one size, i.e. microdot, is detected then a suitably equipped device/copier would recognize that the document should not be copied.

7.2 Claims 6, 20 & 23 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Turho (5,635,694) as interpreted in view of the teachings of either Whitehouse (5,319,562) or Tonges et al (4,175,774) or Gordon (4,891,666) or Mowry, Jr. (5,954,368).

7.2.1 In regard to claim 6, Tuhro ('694) discloses envelope 1 with multi-bit digital data encoded in a pixel by pixel basis in cancellation mark 7 so as to prevent fraudulent copying of the mark, note fig. 4 which clearly shows that the encoded information is contained within a larger printed structure. As a skilled artisan would recognize, such an encoding of data, within an image is a fragile digital watermark which would not be reproducible by the scanning and copying elements most photocopiers, (as evidence of this statement see either:

A) the teachings of Whitehouse (5,319,562) in the environment of preventing copying of printed security markings, such as postage indicia/markings, it was known in 1994 that it is desirable to use a printing resolution for the security marking that is beyond the capability of a photocopier to reproduce; or

B) the teachings of either:

(1) Tonges et al (4,175,774) in the environment of preventing copying of printed security markings; or

(2) Gordon (4,891,666) in the environment of preventing copying of printed security markings; or

(3) Mowry, Jr. (5,954,368) in the environment of preventing copying of printed security markings;

that teach that it in 1979, 1990 & 1999, respectively, it was known to use dots of two different sizes when printing valuable documents where one size can be detected and copied by a photocopier and the second size is too small to be detected and copied by a photocopier.

7.2.2 In regard to claims 20 & 23, in view of the level of skill of one of ordinary skill at the time of the invention as evidenced by the teachings of either Whitehouse (5,319,562) or Tonges et al (4,175,774) or Gordon (4,891,666) or Mowry, Jr. (5,954,368) above, one of ordinary skill would have recognized that the resolution of the encoded information printed in Tuhro ('694) is beyond the capability of most if not all photocopiers to reproduce. Therefore, if someone attempted to copy the postmark and information contained therein as taught by Tuhro ('694), then the copy that would be produced by a photocopier would be degraded in a foreseeable manner, that is it would not be readable and hence if the encoded information as taught by Tuhro ('694) is not readable, then one of ordinary skill could determine whether the encoded information as taught by Tuhro ('694) is the original or a copy.

7.2.3 In view of the above, one of ordinary skill at the time of the invention would have recognized that any reproduction of the encoded information would be corrupted so that it could not be properly decoded.

7.2.3 In regard to the scanning of claim 23, it is noted that standard photocopiers must first obtain a scanned image of an item before the item may be reproduced.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 5 & 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilham (4,934,846) in view of the IBM Technical Disclosure Bulletin and McDonough et al (3,928,226) as suggested by Whitehouse (5,319,562).

8.1.1 In view of the affidavit of Dr. Adnan Alattar the word "steganographic" is defined to mean using a form of encoding or encryption information when printing/recording the information in or on an item such that a human may not readily perceive that the encoded/encrypted information is present in or on the item.

8.1.2 In regard to claims 5 & 8-10, Gilham ('846) discloses in the environment of printing postage indicia/stamps, an indicia 11,12 that has been printed on envelope 15. Where indicia 11,12 (second information) includes an "optically discernable" machine readable "data" that includes an indication of the meter's license number (first information) and hence the "device used in franking said envelope", (see column 1, lines 15-19, "The franking consists of ... license number of the franking machine."; and column 1, lines 57-62, "The data represented by the bar code ... postage value ... license number of the franking machine.").

8.1.3 In regard to the barcode of Gilham ('846), it is noted that one of ordinary skill at the time of the invention would have readily recognized that:

A) a barcode is composed of a sequence of one or more bars/symbols comprising light/dark spaces that are grouped together in a sequence to form a character and that one or more character sequences are grouped together to convey information.

B) the process of watermarking is a process of combining first information with different second information to form a composite information where the act of combining does not visibility obstruct the second information.

C) since, either:

(1) the process of combining the meter's serial number with the other information and then converting the combined information into a barcode; or

(2) the process of separately converting the meter's serial number and the other information into barcodes that are then combined to form a single barcode; as taught by Gilham ('846) would not alter the final appearance of the barcode of Gilham ('846), all that an unauthorized observer would see is the final barcode and not the actual information contained within the barcode.

D) the system of Gilham ('846) uses barcodes to convey information, although one of ordinary skill at the time of the invention could decode the barcode to obtain the sequence of alpha/numeric characters that is represented by the barcode, such a sequence of alpha/numeric characters would be meaningless to one of ordinary skill unless the skilled artisan knew the exact sequence and/or placement of the particular pieces of information contained within the sequence of alpha/numeric characters that is represented by the barcode.

Hence one of ordinary skill at the time of the invention would have recognized that the indicia and barcode of Gilham ('846) that includes a barcode does contain hidden first information within other second information without altering the appearance of the second information and therefore would be recognized as encoded information on an envelope that indicates the device used to frank the envelope.

8.1.4 However, since the barcode contained within the indicia of Gilham ('846) would present a representation of data that is apparent to a human, it would not be recognized as being steganographic as this term would be understood by one of ordinary skill at the time of the invention. In this regard it is first noted that:

A) the IBM Technical Disclosure Bulletin teaches that in order to save space it is possible to print a barcode using either "ultraviolet" or "fluorescent" ink over another character, where when a human views the resulting combination of the character and the barcode, then the resulting barcode, that may be detected and decoded using a suitable detector that could read and properly decode the barcode, would be invisible to a human viewing the combination so that the underlying character is clearly visible to the human; and

B) McDonough et al (3,928,226) in the environment of printing security markings such as postage indicia teaches that it was known in 1975, to printed security markings

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using fluorescent ink that may be detected using ultraviolet light to so as to aid in the detection of encoded information contained in the postage indicia/stamps; and

C) Whitehouse (5,319,562) teaches 1994 in the environment of printing security markings it is desirable to print the security markings, such as postage indicia/markings, using a method that would prevent duplication of the security making by photocopiers.

Since:

A) Whitehouse (5,319,562) teaches that it is desirable to print the security markings using a method that would prevent duplication of the security making; and

B) the IBM Technical Disclosure Bulletin teaches that printing a barcode using either "ultraviolet" or "fluorescent" ink over another character results in the , where when a human views the resulting combination

C) McDonough et al (3,928,226) teaches that it was known to use fluorescent ink when printing security markings;

then it would have been obvious to one of ordinary skill at the time of the invention that the postage indicia printing machine/process of Gilham ('846) could be modified to print the human apparent security marking or barcode of Gilham ('846) using ultraviolet ink as taught by either McDonough et al (3,928,226) or the IBM Technical Disclosure Bulletin in order to produce a more secure security marking as taught by Whitehouse (5,319,562).

8.1.5 It is now noted that one of ordinary skill would recognize the resulting of printing of such an indicia on an envelope would result in an envelope that has printing thereon a steganographic encoded representation of plural bits of digital data that does not present human-apparent evidence of any data representation.

8.1.6 In regard to the language of claims 5 & 8 and in particular the phrase "wherein said steganographic encoding represents plural bits of digital data but does not present human-apparent evidence of any data representation", it is noted that as recited in these claims this phrase:

A) this phrase does not alter the function/purpose of the claimed envelope; and

B) recites subject matter that is not in fact used but a mere recitation of an intended purpose of this data;

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this phrase it is deemed to be printed matter that is non-function descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.1.7 In regard to claim 11, it is noted that one of ordinary skill in the art of printing at the time of the invention would recognize a postage indicia printed on an envelope by the Gilham ('846) in view of the IBM Technical Disclosure Bulletin and McDonough et al ('226) as suggested by Whitehouse ('562) would by the action of printing multiple items over one another by depositing layers of material on the surface of an envelope would in fact take the form of texturing the surface.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example, either:

(1) Gilham (4,934,846) discloses in the environment of printing postage indicia/stamps, the use of an indicia 11,12 that has been printed on envelope 15, where indicia 11,12 includes an "optically discernable" machine readable "data" that includes an indication of the meter's license number; or

(2) McDonough et al (3,928,226) discloses that it is well established that the post office uses fluorescent ink in post marks and stamps, so as to identify the post mark or stamp on the envelope; or

(3) Turho (5,635,694) discloses envelope 1 with multi-bit digital data encoded in a pixel by pixel basis in cancellation mark 7 so as to prevent fraudulent copying of the mark, note fig. 4 which clearly shows that the encoded information is contained within a larger printed structure; or

(4) Whitehouse (5,319,562) disclose in the environment of preventing copying of printed security markings, such as postage indicia/markings, it was known in 1994 that it is desirable to use a printing resolution for the security marking that is beyond the capability of a photocopier to reproduce; or

(5) Tonges et al (4,175,774) or Gordon (4,891,666) or Mowry, Jr. (5,954,368) in the environment of preventing copying of printed security markings that teach that it in 1979, 1990 & 1999, respectively, it was known to use dots of two different sizes when printing valuable documents where one size can be detected and copied by a photocopier and the second size is too small to be detected and copied by a photocopier; or

(6) IBM Technical Disclosure Bulletin: "Low-Cost Kanji Data Entry System Using Invisible UPC Codes", 01 January 1991, vol. 33, no. 8, page 112 which discloses the use of barcodes printed in ultraviolet or infrared ink to convey information.

B) however in regard to claim 12 the prior art fails to fairly teach or suggest a process in which a machine triggered to respond to instruction obtained as a result of optically scanning an indicia on the item of mail after an item of mail has been delivered to its destination. Claims 13-18 are allowable for the same reason.

C) however in regard to claim 19, the prior art fails to fairly teach or suggest an article comprising an envelope with a first franking indicia and a second indicia that indicates authorized users of an envelope that must cooperate in order to confirm that the user of the envelope is authorized to use the envelope. Claim 24 is allowable for the same reason.

D) however in regard to claim 21, the prior art fails to fairly teach or suggest an article comprising an envelope with two different types of watermarks, where one of the

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watermarks will be degraded in a foreseeable manner if copied and a second watermark that is relatively robust. Claim 22 is allowable for the same reason.

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the 35 U.S.C. § 102 rejections:

A) in regard to the use of multiple references in a rejection under 35 U.S.C. § 102 as clearly set forth in the MPEP the user of multiple references may be used pursuant to MPEP §§ 2112 & 2131.01.

B) it is noted that claims 5-11 are directed solely to an article or manufacture that is an envelope, where the information contained on the envelope does not change the function of the envelope and therefore is not functionally related to the envelope so as to impart a new function or structure to the recited envelope and hence pursuant to MPEP § 2114 these claims fail to recite any structure that would be sufficient in order to distinguishable the claimed envelope over the prior art.

C) it is noted in regard to claims 6, 20 & 23, that the arguments relied upon by applicant are based on a missing reading of either:

(1) the reference to Tow (5,315,098) which merely states that the encoded data may be used by machines such as a photocopier and not that the encoded data would survive being photocopied as stated in the claims; or

(2) the Daniele (5,444,779) which merely states that glyphs that are used to monitor and record copyright and royalty information must survive multiple generations of copies, where as the purpose of the glyphs of the instant invention is not to be reproduced during copying and hence are not for the same purpose.

D) in regard to claim 11, since applicant has continually failed to define "texturing of the surface" in a particular manner, applicant's contention that the examiner has gone beyond the teachings of the reference by holding that the depositing of ink on an envelope textures the surface of the envelope is not grounded in any basis of fact, since it clearly ignores the practical physics involved in applying ink to any surface.

E) in regard to claim 7;

(1) in regard to the envelope, it is noted that one of ordinary skill at the time the invention was made would have clearly recognized that the substrate on which the encoded indicia is placed in claim 7 does not affect the function/purpose of the encoded information in the indicia, hence substrate on which the encoded information is placed in claim 7 is nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). A common situation involving nonfunctional descriptive material is a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Therefore one of ordinary skill at the time the invention was made would have recognized that any encoded information that would prevent copying based on the detection of encoded information would meet the language of this claim.

(2) since:

(a) claim 7 fails to recite exactly how the information is encoded in the indicia; and

(b) the purpose of encryption is to conceal, that is hide, information,

one of ordinary skill at the time the invention was made would have recognized that encryption would be with scope of the claim 7.

In view of the above, applicant is arguing unclaimed distinctions and merits and therefore applicant's argument's are non persuasive.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

12.2 The fax phone number for **OFFICIAL FAXES** is (571) 273-8300.

12.3 The fax phone number for **AFTER FINAL FAXES** is (571) 273-8300.

09/19/05


Edward R. Cosimano
Primary Examiner Unit 3639